

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Art Unit: 1654
)
JANSSON, John-Olov) Examiner: LUKTON, D.
)
Serial No.: 10/530,866) Washington, D.C.
)
Filed: April 11, 2005) October 15, 2008
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For: USE OF GHRELIN FOR) Docket No.: JANSSON-7
TREATING MALNUTRITION IN)
GASSTRECTOMIZED...) Confirmation No.: 2241

PETITION UNDER 37 CFR 1.181 TO WITHDRAW FINALITY

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

S i r :

Applicants hereby petition the Commissioner to exercise supervisory authority under 37 CFR 1.181 and withdraw the finality of the action mailed July 22, 2008. This is believed to be a "no fee" petition, but if we are mistaken, the petition fee may be charged to deposit account 02-4035.

Statement of Facts

1. A final rejection was previously mailed on October 29, 2007.

2. On January 29, 2008, Applicants filed an amendment after final.

3. The advisory action mailed February 28, 2008 refused to enter the January 29, 2008 amendment on the basis that it allegedly raised new issues that would require further consideration and/or search.

4. On April 23, 2008, applicants filed an RCE, requesting entry of the refused January 29, 2008 amendment.

5. The instant rejection was made final even though it entered an amendment previously refused entry.

6. On September 19, Counsel left Examiner Lukton a voicemail requesting reconsideration of the holding of finality, but the Examiner did not respond.

Argument

1. MPEP 706.07(h) (VIII) states:

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP 706.07(b) for making a first action final in a continuing application are met.

MPEP 706.07(b), third paragraph states:

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of the matter was raised.

Since the exception (A) specified in the third paragraph of MPEP 706.06(b) is applicable, the imposition of finality was improper. A supplemental action should be mailed which withdraws finality.

2. Applicants respectfully request that the shortened statutory period for response be reset to run three months from the mail date of the supplemental action. As the PTO is aware, finality sharply constrains what amendments can be made and/or evidence presented. If finality is withdrawn, applicants have more options. Applicants should not be forced to consider those

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options in the tag-end of the original period for response.

Respectfully submitted,

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